

## **REMARKS**

### **I. 35 U.S.C. § 112, Second Paragraph, Rejections**

Claims 1-18 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as their invention. Specifically, it was asserted that it was unclear whether the list is sent only once (e.g., when a user plugs the phone jack into the wall or only the first time the receiver goes off-hook) or each time the receiver goes off-hook. Applicants respectfully traverse this rejection.

Applicants have particularly pointed out and distinctly claimed the invention. Each of the independent claims recites specific acts or elements that are performed in response to a specific condition (i.e., a telephone set being connected to a telephone line). Applicants are not aware of any requirement that a claim must state whether its recited acts are performed only once or each time a condition is met. Accordingly, Applicants respectfully request reconsideration and withdrawal of these rejections.

### **II. 35 U.S.C. § 102(b) Rejections**

Claims 1-18 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,930,350 to Johnson. Applicants respectfully request reconsideration and withdrawal of those rejections.

As a first matter, Applicants note that the claim elements cited in the Office Action are not recited in any of the pending claims. Instead, those claim elements were recited in the original version of Claim 1 of the *parent* application. Original Claim 1 in the parent application was rejected as being anticipated by Johnson. In response to that rejection, Applicants amended Claim 1 to state that the acts of identifying the telephone line to which the telephone set has been connected, retrieving the speed dial list from the database based on said identifying, and

communicating a machine-readable form of the speed dial list to the telephone set via the telephone network were performed in response to detecting that a telephone set has been connected to the telephone line. The Examiner agreed that Johnson did not teach performing these acts in response to detecting that a telephone set has been connected to the telephone line and withdrew the rejections and allowed the application.

With respect to independent Claims 1, 8, and 13 in the pending application, it appears that the Examiner's concern is that the phrase "in response to" can read on any system that sends a speed dial list to a remote phone, since a connection would have to be sensed by the system before the speed dial list is sent. Applicants have amended these claims to add additional elements to clarify the claims. Specifically, Applicants have added two additional acts to Claim 1 that take place in response to detecting that a telephone set has been connected to a telephone line: identifying the telephone line to which the telephone set has been connected and retrieving a speed dial list from a database based on the identifying, wherein the speed dial list is associated in the database with the telephone line. Similar elements have been added to independent Claims 8 and 13. These elements are not shown in Johnson. Johnson discloses a system where phone numbers in a pre-programmed database are assigned to a speed dial list in response to a user receiving an *email, fax, or printout – not in response to detecting a telephone set has been connected to a telephone line as recited in the claims.* Johnson does not perform any function whatsoever in relation to a speed dial list when a telephone set is connected to a telephone line.

With respect to independent Claim 7, that claim recites receiving a telephone call automatically placed by a telephone set in response to the telephone set being connected to a telephone line. Claim 7 also recites receiving, within that automatically-placed telephone call, a selection of an option to download a speed dial list. These elements are not shown in Johnson.

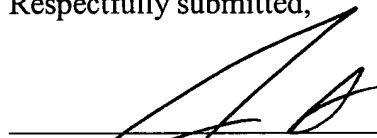
In Johnson, phone numbers in a pre-programmed database are assigned to a speed dial list in response to a user receiving an email, fax, or printout. There is no teaching in Johnson of receiving a telephone call automatically placed by a telephone set in response to the telephone set being connected to a telephone line and receiving, within that automatically-placed telephone call, a selection of an option to download a speed dial list.

### **III. Conclusion**

In view of the foregoing amendments and remarks, Applicant submits that this application is in condition for allowance. Reconsideration is respectfully requested. If there are any questions concerning this Amendment, the Examiner is asked to phone the undersigned attorney at (312) 321-4719.

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Respectfully submitted,



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